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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/823,588	03/30/2001	S. Sean Moore	UV/192	6830
1473 7590 10/15/2007 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER LASTRA, DANIEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 10/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/823,588	Applicant(s) MOORE ET AL.	
	Examiner DANIEL LASTRA	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-10,12-18,20-24,26-37,40-43,45-48 and 50-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-10,12-18,20-24,26-37,40-43,45-48 and 50-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 6-10, 12-18, 20-24, 26-37, 40-43, 45-48 and 50-63 have been examined. Application 09/823,588 (SYSTEM AND METHOD FOR METADATA-LINKED ADVERTISEMENTS) has a filing date 03/30/2001.

Response to Amendment

2. In response to Non Final Rejection filed 01/10/2007, the Applicant filed an Amendment on 07/05/2007, which amended claim 35.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 37 recite "receiving at the user equipment the plurality of advertisements related to at least one object". Said limitation is indefinite because it seems to recite that a plurality of advertisements are linked to a single object when Applicant's specification teaches that an object is linked to an URL source and said URL source is used to pull or push advertisements located in said source (see Applicant's specification page 12). For purpose of art rejection, said limitation would be interpreted as metadata that contains a source address to download an advertisement from a location, where the advertisement that is presented to a viewer may be the advertisement currently available at the source (see Applicant's specification page 6, lines 22-35).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 6-18, 20-24, 26-34, 37, 40-43, 45-48 and 50-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al (U.S. 6,357,042).

As per claims 1, 18, 32, 36, 37, 43, 48 and 53-63, Srinivasan teaches:

A method executed by at least one computer processor for providing metadata-selected advertisements, comprising:

receiving at user equipment media comprising at least one object (see “CPE” or “set top box”; col 7, lines 35-50; col 12, lines 20-40; col 17, lines 63-67; col 20, lines 45-55; col 22, lines 1-35; col 29, lines 45-65; col 31, lines 1-15), metadata associated with the at least one object and containing a description of the at least one object, and

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metadata associated with a plurality of advertisements related to the at least one object (see column 5, line 62 – column 6, line 19; column 6, lines 10-18 “advertisements, may for example, be associated with a tracked object”; column 32, lines 22-30);

receiving at the user equipment the plurality of advertisements related to the at least one object (see col 22, lines 1-10; col 31, lines 1-15; col 33, lines 1-20; col 38, lines 35-50);

displaying the media and the at least one object on a viewing device (see column 7, lines 37-49) at the user equipment (see col 7, lines 25-50; col 22, lines 1-35; col 30, lines 40-65);

receiving a user selection of one of the at least one object displayed on the viewing device (see column 7, lines 35-50; col 22, lines 1-10);

processing metadata associated with the object selected by the user (see col 3, lines 10-20; col 6, lines 10-20; col 12, lines 25-40; col 22, lines 1-10; column 32, line 21 – column 33, line 3). Srinivasan assigns metadata (i.e. URLs) to an entity in a video and the user click said entity in said video and receive advertisements from said clicking.

comparing at the user equipment the metadata associated with the object selected by the user with the metadata associated with the plurality of advertisements related to the object (see column 7, lines 25-50; col 12, lines 20-35; col 22, lines 1-10). ;
and

selecting at the user equipment one of the plurality of advertisements related to the object based on the comparison (see column 7, lines 25-50; col 22, lines 1-10; col 32, lines 20-40)

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monitoring the selected advertisement (see column 7, lines 35-49; column 31, line 45-56);

downloading to the user equipment the plurality of advertisements related to the media (see col 29, lines 45-65; col 31, lines 1-15; col 33, lines 1-5; col 34, lines 55-65);

monitoring the selected advertisement, collecting data on the selected advertisement (see column 7, lines 36-49), recording the data and downloading the selected advertisement and displaying the selected advertisement (see col 12, lines 20-40; column 22, lines 1-35; col 31, lines 47-64).

As per claim 2, Srinivasan teaches:

The method of claim 1 further comprising displaying the selected advertisement on the viewing device (see column 12, lines 20-35; column 32, lines 21-64).

As per claims 6, 20, 40, 45 and 50, Srinivasan teaches:

The method of claim 1 wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 7, 21, 41, 46 and 51, Srinivasan teaches:

The method of claim 1 wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56; col 37, lines 5-67).

As per claims 8, 22, 42, 47 and 52, Srinivasan teaches:

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The method of claim 1 further comprising storing the metadata associated with the at least one object and the metadata associated with the plurality of advertisements (see column 17, lines 20-25; col 32, lines 21-31; col 33, lines 1-3).

As per claims 9 and 23, Srinivasan teaches:

The method of claim 8 wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are stored on a single storage device (see figure 16; column 32, lines 21-31; col 34, line 55 – col 35, line 20).

As per claims 10 and 24, Srinivasan teaches:

The method of claim 8 wherein the metadata associated with the at least one object and the metadata associated with the plurality of advertisements are stored on a plurality of storage devices (see figure 16, column 30, lines 53-67).

As per claim 11, Srinivasan teaches:

The method of claim 1 further comprising receiving the selected advertisement (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 12 and 26, Srinivasan teaches:

The method of claim 1 wherein the plurality of advertisements are received within the media (see column 12, lines 20-35; column 32, lines 21-56).

As per claims 13 and 27, Srinivasan teaches:

The method of claim 1 wherein the plurality of advertisements are received on a broadcast channel on which the media is also received (see column 31, lines 15-56).

As per claims 14 and 28, Srinivasan teaches:

The method of claim 1 wherein the plurality of advertisements are received on a separate broadcast channel from the media (see column 31, lines 15-56).

As per claims 15 and 29, Srinivasan teaches:

The method of claim 1 further comprising storing the selected advertisement (see column 32, lines 21-55).

As per claims 16 and 30, Srinivasan teaches:

The method of claim 15 wherein the selected advertisement is stored on a single storage device (see figure 16, column 32, lines 21-31) .

As per claims 17 and 31, Srinivasan teaches:

The method of claim 15 wherein the selected advertisement is stored on a plurality of storage devices (see figure 16, column 32, lines 21-31).

As per claim 33, Srinivasan teaches:

The method of claim 32 wherein the metadata associated with the object and the metadata associated with the plurality of advertisements further contain at least one source address (see column 32, lines 21-40).

As per claim 34, Srinivasan teaches:

The method of claim 33 wherein at least one of the at least one source address is a Uniform Resource Locator (see column 32, lines 21-40).

Claim 54, Srinivasan teaches:

The method of claim 1 further comprising periodically receiving the plurality of advertisements from one or more remote locations (see col 32, lines 1-5).

Claim 55, Srinivasan teaches:

The method of claim 1 further comprising receiving the plurality of advertisements from one or more remote locations in response to requests made by the user equipment (see col 32, lines 20-45).

Claim 56, Srinivasan teaches:

The method of claim 1 further comprising polling one or more remote location for the plurality of advertisements (see col 34, lines 10-25).

Claim 57, Srinivasan teaches:

The method of claim 1 further comprising storing the plurality of advertisements at the user equipment (see col 34, lines 55-67; col 33, lines 1-20).

Claim 58, Srinivasan teaches:

The method of claim 2 further comprising ordering one or more items displayed by the selected advertisement (see col 32, lines 35-40).

Claim 59, Srinivasan teaches:

The system of claim 37 wherein the at least one receiver periodically receives the plurality of advertisements from one or more remote locations (see col 32, lines 1-5).

Claim 60, Srinivasan teaches:

The system of claim 37 wherein the at least one receiver receives the plurality of advertisements from one or more remote locations in response to requests made by the processor (see col 32, lines 20-45).

Claim 61, Srinivasan teaches:

The system of claim 37 wherein the processor is configured to poll one or more remote locations for the plurality of advertisements (see col 34, lines 10-25).

Claim 62, Srinivasan teaches:

The system of claim 37 further comprising at least one storage unit for storing the plurality of advertisements at the user equipment (see col 34, lines 55-67; col 33, lines 1-20).

Claim 63, Srinivasan teaches:

The system of claim 37 wherein the processor is operative to order one or more items displayed by the selected advertisement (see col 32, lines 32-40).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Srinivasan et al (U.S. 6,357,042).

As per claim 35, Srinivasan does not expressly teach:

The method of claim 33 wherein at least one source address is a telephone number. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Srinivasan would include in the source address the advertiser's telephone number therefore giving users the advertiser's contact information.

Response to Arguments

6. Applicant's arguments filed 07/05/2007 have been fully considered but they are not persuasive. The Applicant argues that Applicant's specification page 12, lines 20-30 which recites that "that advertisement may be selected by comparing the metadata of the media or selected object with metadata from advertisements" conveys that one object may be related to a plurality of advertisements. The Examiner answers that Applicant's claim 1 recites "receiving at the user equipment the plurality of advertisements related to the at least one object" which is totally different from comparing metadata of selected object with metadata from advertisements. In other word, comparing the metadata of a object with the plurality of advertisements does not mean that the plurality of advertisements are related to at least one object. Therefore, contrary to Applicant's argument, said limitation would be interpreted as simply as selecting an ad to be displayed based upon comparing said ad's metadata with a selected object metadata.

The Applicant argues that claims 1 and 37 are directed to selecting an advertisement from a plurality of advertisements received locally at the user equipment by comparing locally at the user equipment metadata associated with a selected object and metadata associated the plurality of advertisements. The Applicant argues that a general reference to using "additional network-stored information about an entity" to select advertisements when a users selects the entity does not expressly anticipate each and every element as set forth in claims 1 and 37. The Examiner answers that Srinivasan teaches selecting at the user station (*i.e.* set top box) one advertisement

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from a plurality of received advertisements based upon the selection of an interactive content in an advertisement (i.e. URL metadata) and user's profile (see col 34, lines 1-25 and 55-67). Therefore, contrary to Applicant's argument, in Srinivasan the user device (i.e. set top box) would select to display those ads targeted to profile and object metadata (i.e. URL interactive content) and not other ads that may be sent simultaneously, where said selection is done locally at the user's station (i.e. set top box).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

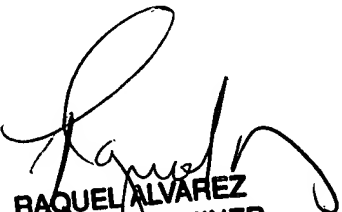
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra
September 30, 2007


RAQUEL ALVAREZ
PRIMARY EXAMINER